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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92025859
Party	Plaintiff Empresa Cubana Del Tabaco d.b.a Cubatabaco
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Registration No. 1147309
For the mark COHIBA
Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273
For the mark COHIBA
Date registered: June 6, 1995

EMPRESA CUBANA DEL TABACO d.b.a. CUBATABACO,

Petitioner,

v.

Cancellation No. 92025859

GENERAL CIGAR CO., INC.,

Respondent.

PETITIONER EMPRESA CUBANA DEL TABACO d.b.a CUBATABACO'S OPPOSITION TO GENERAL CIGAR CO., INC.'S MOTION TO STRIKE PETITIONER'S REBUTTAL TRIAL EVIDENCE AND TESTIMONY OF SUSAN BAILEY, DEAN J. GLUTH and CHARLES LINEHAN

Petitioner Empresa Cubana del Tabaco d.b.a. Cubatabaco ("Cubatabaco" or "Petitioner") respectfully file this Opposition to General Cigar Co., Inc.'s ("GCC" or "Respondent") Motion to Strike Petitioner's Rebuttal Trial Evidence and Testimony of Susan Bailey, Dean J. Gluth, and Charles Linehan.

INTRODUCTION

This cancellation proceeding, concerns the registration of the COHIBA trademark for cigars. Petitioner, a Cuban company, has sought the registration of COHIBA for cigars on the basis of its Cuban registration. It seeks cancellation of Respondent's registration of COHIBA for

cigars, which has been cited against Petitioner's application by the USPTO. After years of extensive discovery and motion practice, trial testimony has been completed, and Petitioner's trial brief is due July 1, 2021. 332 TTABVUE 4.

Respondent has moved to strike the declaration of Susan Bailey, 308-311 TTABVUE, a non-attorney staff member in counsel's office, solely on the ground that her testimony is improper rebuttal. 333 TTABVUE 12-18. However, under explicit Board practice, this motion should be denied, as objections on this ground are to be filed as an evidentiary objection with Respondent's trial brief. In the alternative, the Board's consideration of Respondent's motion should be deferred (or denied without prejudice) until consideration of the Parties' trial briefs.

In any event, Ms. Bailey's Declaration is not improper rebuttal testimony. It responds to evidence concerning the impact of the U.S. embargo against Cuba on likelihood of confusion advanced by Respondent in its trial testimony that, under Board precedent, *Respondent* was obligated to come forward with during its trial period.

Respondent also moves to strike the testimony of Dean J. Gluth and Charles Linehan, two investigators retained by Petitioner after Respondent's submission of its trial testimony. As Respondent's principal argument is that their testimony also is improper rebuttal, this motion should likewise be denied under the same Board practice or, in the alternative, deferred. 333 TTABVUE 14. Respondent's additional ground to strike this testimony on the basis of improper disclosures should be carried with Respondent's principal argument that the testimony is improper rebuttal evidence. *Id.* at 18-21. Further, the Gluth and Linehan testimony is neither improper rebuttal testimony nor barred by improper disclosure.

Respondent's motion exceeds the leave granted by the Interlocutory Attorney, who, following a telephone conference with the Parties on March 31, 2021, only granted Respondent

leave to file a motion to strike Respondent's rebuttal witnesses "due to improper or inadequate pretrial disclosures." 331 TTABVUE 5. In clear violation of the limited leave granted by the Interlocutory Attorney, Respondent seeks to strike the Bailey evidence and declaration exclusively on the ground that it is improper rebuttal evidence, and seeks to strike the Gluth and Linehan Declarations principally on that ground.

By Stipulation, 331 TTABVUE 5-6, the Parties jointly requested that litigation of Respondent's objections to the Bailey, Gluth and Linehan testimony based on improper or inadequate pretrial disclosures be deferred until the Parties' submission of their trial briefs and evidentiary objections. The Board "deferred" consideration of this Joint Request "pending the Board's review of Respondent's motion." 332 TTABVUE 4. For the reasons set forth in further detail below, in the event the Board does not deny the instant motion, the Joint Request should be approved now that the Board has the opportunity to review Respondent's motion.

PROCEDURAL HISTORY

The undersigned counsel declares that the following factual statements are true and correct.

This cancellation proceeding is before the Board on reversal and remand by the Federal Circuit. *Empresa Cubana del Tabaco v. Culbro Corp.*, 753 F. 3d 1270, 1276 (Fed. Cir. 2014); 83 TTABVUE 11. On January 15, 1997, Petitioner, a Cuban company, filed an application in the USPTO to register COHIBA for cigars and related goods on the basis of its Cuban registration, and a petition to cancel Respondent's two registrations for COHIBA for cigars (Reg. Nos. 1147309, issued on February 17, 1981, and 1898273, issued on June 6, 1995), both of which the PTO has cited against Petitioner's application as likely to cause confusion.

The cancellation proceeding was suspended on January 28, 1998, pending the outcome of

litigation between the Parties in federal court, *Empresa Cubana del Tabaco v. Culbro Corp.*, 97 Civ. 8399 (S.D.N.Y.) (the "Federal Action"). 15 TTABVUE. After a lengthy bench trial that concluded in June 2003, the District Court ordered cancellation of Respondent's two registrations and enjoined its use of the COHIBA mark. *Empresa Cubana del Tabaco v. Culbro Corp.,* 2004 WL 925647 (S.D.N.Y. April 30, 2004); 70 U.S.P.Q.2d 1650 (S.D.N.Y. 2004).

The Court of Appeals for the Second Circuit reversed and vacated the District Court's judgment on the basis of the Cuban Assets Control Regulations ("CACR," 31 C.F.R. Part 515). *Empresa Cubana del Tabaco v. Culbro Corp.*, 399 F.3d 462, 476-77 (2d Cir. 2005). The Supreme Court denied Petitioner's petition for a writ of *certiorari* on June 26, 2006. *Empresa Cubana*, 547 U.S. 1205 (2006). After further proceedings in the District Court and the Second Circuit, *Empresa Cubana del Tabaco v. Culbro Corp.*, 478 F. Supp. 2d 513, 21-22 (S.D.N.Y. 2007), *aff'd* 541 F.3d 476, 479 (2d Cir. 2008); *Empresa Cubana del Tabaco v. Culbro Corp.*, 89 U.S.P.Q.2d 1834 (S.D.N.Y. 2008) *rev'd* 97 U.S.P.Q.2d 1510 (2d Cir. 2010), proceedings on Petitioner's cancellation petition before the Board were resumed. 60 TTABVUE 3.

On March 14, 2013, the Board granted Respondent's motion for summary judgment dismissing Petitioner's Amended Petition. 75 TTABVUE 16-17. On June 4, 2014, the Court of Appeals for the Federal Circuit unanimously reversed the Board's decision and remanded for further proceedings. *Empresa Cubana del Tabaco v. Culbro Corp.*, 753 F. 3d 1270, 1276 (Fed. Cir. 2014); 83 TTABVUE 11. It held, *inter alia*, that the Cuban Assets Control Regulations did not bar the Amended Petition or the relief it sought; that Petitioner has standing; and that neither Petitioner's claim for cancellation nor any of the grounds for cancellation it asserts are barred by issue or claim preclusion on account of the prior Federal Action. The Supreme Court denied Respondent's petition for a writ of *certiorari* on February 23, 2015. *General Cigar Co., Inc. v.*

Empresa Cubana del Tabaco, 135 S.Ct. 1401 (2015). On October 28, 2015, the Board vacated its March 14, 2013 order and ordered a resumption of proceedings. 88 TTABVUE.

The Parties engaged in extensive discovery between October 28, 2015 and the close of discovery on August 6, 2018.[1]

On September 20, 2018, Petitioner timely filed its pretrial disclosure. Petitioner supplemented these pretrial disclosures eight days later, on September 28, 2018, identifying Susan Bailey, a non-attorney staff member of undersigned counsel, as a witness from whom it may take testimony during its trial period if the need arises. On September 15, 2019, Petitioner submitted the trial testimony declaration of Susan Bailey, 221 TTABVUE.

Respondent has never objected to Petitioner's supplemental pretrial disclosures, nor did it cross-examine Ms. Bailey during Petitioner's trial period.

Prior to the close of its trial period on September 29, 2020, Respondent submitted its trial testimony and evidence. It consisted of trial testimony declarations by its employees and its purported expert, portions of discovery depositions taken in this proceeding of twelve (12) witnesses, portions of discovery depositions, written direct trial testimony taken in the Federal Action from scores of witnesses, and scores of exhibits from the Federal Action as well as portions of the trial transcript in the Federal Action. 264-301 TTABVUE.

Of particular relevance to the instant motion, Respondent offered testimony that there is no likelihood of confusion because consumers know that the U.S. trade embargo prohibits the sale of Cuban cigars in the United States. Its evidence on that issue included declarations by its employees and purported expert that:

[1] By Stipulation approved by the Board, evidence presented in the Federal Action may be presented here, and discovery taken in the Federal Action is to be treated as discovery taken here. 89 TTABVUE 2; 91 TTABVUE.

- "U.S. consumers of premium cigars … are aware that no Cuban cigar may be commercially sold in the United States, and that any cigar they buy from a U.S. cigar store or a U.S. cigar Internet or mail-order merchant is not a Cuban cigar." 287 TTABVUE 5 (Declaration of Steven Abbot, Respondent's Senior Brand Manager);

- Mr. Abbot "do[es] not believe there are any appreciable number of premium cigar smokers who are unaware that Cuban cigars are barred from sale in the United States, or who believe that cigars that can be commercially purchased in the United States either were made in Cuba or originate with or are approved by a Cuban manufacturer." *Id.* at 20

- "Cigar smokers and merchants generally know that under Federal law, it is illegal to sell any Cuban cigar in the United States." 282 TTABVUE 7 (Declaration of Eugene Paul Richter III, Respondent's Vice-President of Sales)

- "One very important fact in the cigar market, which in my experience is known even potential smokers of premium cigars, is that the U.S. embargo against Cuba … prohibits the commercial importation or sale of Cuban cigars in the U.S. … U.S. premium cigar consumers therefore know that if they are buying a Cohiba cigar from a U.S. seller, it is not a Cuban cigar." 273 TTABVUE 11 (Declaration of Richard Carleton Hacker, Respondent's purported expert).

Petitioner timely filed its rebuttal disclosures on January 15 and 16, 2021. 252 TTABVUE; 333 TTABVUE 19. Petitioner identified Ms. Bailey as well as two investigators, Dean J. Gluth and Charles Linehan, as witnesses from whom it may take testimony. Petitioner timely submitted rebuttal testimony declarations by these three witnesses on February 12, 2021, during its rebuttal period. 307-311, 326 TTABVUE.

Their declarations, discussed more fully below, sought to rebut Respondent's introduction of testimony that U.S. consumers know that the U.S. trade embargo prohibits the sale of Cuban cigars in the United States and that there is no likelihood of confusion as a result.

On March 2, 2021, Respondent's counsel sent Petitioner's counsel Notices to Cross-Examine Petitioner's three rebuttal witnesses, together with a letter reserving its right to move to strike their testimony on the basis of "lack of [*sic*] improper or inadequate disclosures." The depositions of these three rebuttal witnesses were taken on March 29, 31 and April 2, 2021.

In a March 16, 2021 email, Respondent's counsel requested that a telephone call Petitioner's counsel had proposed with the Interlocutory Attorney to discuss procedural matters include a joint request: (a) for a schedule for Respondent's motion to strike; and (b) that "the motion [] be considered after trial briefing" and without suspending the proceedings.

Petitioner agreed to Respondent's request concerning the proposed schedule for its motion to strike on the condition that the Parties jointly request that the Board defer consideration of the motion to strike until after trial briefing.

On March 31, 2021, in a telephone conference with the Parties, the Interlocutory Attorney granted Respondent leave to file a motion to strike Respondent's rebuttal witnesses "due to improper or inadequate pretrial disclosures." 331 TTABVUE 5. The instant motion exceeds this limited grant of leave: it seeks to strike the Bailey evidence and Declaration exclusively on the ground that it is improper rebuttal evidence, and seeks to strike the Gluth and Linehan Declarations principally on that ground.

On April 6, 2021, the Parties submitted a joint request that "the Board defer consideration of Respondent's Motion to Strike until the Board's consideration of the Parties' trial briefs and other evidentiary objections" (the "Joint Request"). 331 TTABVUE 6. It also included a schedule for Respondent's motion to strike. *Id.* at 5-6.

The Board "deferred" consideration of the Joint Request "pending the Board's review of Respondent's motion." 332 TTABVUE 4.

LEGAL ARGUMENT

I. Respondent's Motion With Respect to the Bailey Rebuttal Testimony Should Be Denied or Deferred Until Submission of Trial Briefs and Evidentiary Objections; Its Motion with Respect to the Gluth and Linehan Rebuttal Testimony Should Be Denied In Part and Otherwise Deferred, or Deferred in Its Entirety

Board practice is clear and explicit that "[o]bjections to testimony depositions on grounds

other than the ground of untimeliness, or the ground of improper or inadequate notice, generally *should not be raised by motion to strike*." TBMP § 533.03 (emphasis added). "Substantive objections to testimony, that is, objections going to such matters as … improper rebuttal nature of the testimony, *are not considered by the Board prior to final hearing*." TBMP § 707.03(c) (emphasis added) (citing cases).

Contrary to this clear Board practice, Respondent advances as its *only* objection to the rebuttal testimony of Susan Bailey that it is improper rebuttal. 333 TTABVUE 12-18. Respondent even titles its only legal argument concerning Ms. Bailey's testimony and evidence "Cubatabaco's Rebuttal Testimony Is Not Proper Rebuttal Evidence." *Id.* Respondent does *not* assert that there was improper or inadequate notice with respect to Ms. Bailey's rebuttal testimony and evidence.

Moreover, on March 31, 2021, the Interlocutory Attorney had granted Respondent leave to file a motion to strike Respondent's rebuttal witnesses "due to improper or inadequate pretrial disclosures." 331 TTABVUE 5. Leave was *not* granted to file a motion to strike *based solely on improper rebuttal evidence*. *Id.*

For these reasons, the Board should deny Respondent's motion with respect to the rebuttal testimony and evidence of Ms. Bailey. Under the Board practice and rules, the Respondent may raise its objections to the Bailey Declaration and evidence as improper rebuttal with the evidentiary objections it files at the same time as its brief on the merits.

For the same reasons, Respondent's principal argument with respect to Gluth and Linehan—that their testimony is improper rebuttal because it concerns the locations where Respondent's COHIBA cigars are sold—is foreclosed as this juncture. Rather than consider Respondent's objections to the Gluth and Linehan testimony piecemeal, the Board should defer

consideration of Respondent's additional argument of improper disclosure until it may consider both arguments. Further, this would be in accord with what the Parties have previously agreed and jointly requested: that Respondent's motion based on improper disclosures be deferred. *See supra* pp.6-7.

Moreover, there is good reason for the Board to deny or, alternatively, defer consideration of Respondent's motion with respect to all three witnesses because "it is the policy of the Board not to read trial testimony, or examine other trial evidence offered by the parties, prior to deliberations on the final decision." TBMP § 707.03(c); *see also Rowell Laboratories, Inc. v. Canada Packers Inc.*, 215 U.S.P.Q. 523, 529 (T.T.A.B. 1982) (cited by Respondent) (Board "does not read testimony prior to final hearing") (noting denial of motion to strike regularly filed evidence prior to the Board' consideration of the entire record). Here, even a cursory review of Respondent's motion reveals that the Board would need to review substantial trial testimony and evidence to evaluate the motion and opposition. Respondent relies extensively on selected excerpts of testimony from seven (7) witnesses as well as other evidence (consisting of over one hundred and fifty (150) pages) and cites to many other exhibits and testimony. 333 TTABVUE 24-189 (Declaration of Andrew L. Deutsch and supporting exhibits) and 333 TTABVUE 3-8, 10-16 (Respondent's citation to other evidence in this proceeding).

Further supporting denial or deferral is the Board precedent that, when (i) Petitioner has come forward with evidence establishing a *prima facie* case of likelihood of confusion and (ii) Respondent has chosen to attack one or more portions of that evidence, the petitioner may come forward with evidence that rebuts, denies, explains, or discredits that attack, even if that rebuttal evidence could have been presented in petitioner's case-in-chief. *See Sprague Elec. Co., Inc. v. Elec. Utilities Co.*, 209 U.S.P.Q. 88, 93 (T.T.A.B. June 5, 1980); *accord Nationwide Consumer*

Testing Inst., Inc. v. Consumer Testing Lab'ys, Inc., 159 U.S.P.Q. 304, 310 (T.T.A.B. Aug. 28, 1968) ("applicant by choosing … [to present testimony] to establish, notwithstanding, opposer's evidence-in-chief, exclusivity of the term … and the absence of knowledge by the witness and thereby of applicant of use of this or a similar term by anyone else reopened this entire question thereby entitling [opposer] to reply to or rebut any implication or assumption that might be drawn from such testimony"); *Finance Co. v. BankAmerica Corp.*, 205 U.S.P.Q. 1016, 1022 (T.T.A.B. 1980); *see also Data Packaging Corp. v. Morning Star, Inc.*, 212 U.S.P.Q. 109, 113 (T.T.A.B. Sept. 16, 1981) ("The fact that evidence might have been offered in chief does not preclude its admission as rebuttal. In such cases the trier of the facts has discretion to admit rebuttal testimony in the interest of fairness … [including] in *inter partes* trademark proceedings before the Patent and Trademark Office").[2]

Consideration of this precedent's import here is best made on the full record and accompanying analysis that will soon be presented to the Board in any event with the trial briefs, beginning on July 1, 2021. 332 TTABVUE 4. Further, to bring this precedent to bear now, Petitioner would, in essence, have to present its trial brief here, the Board would have to

[2] None of the cases Respondent cites are to the contrary. In *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc.*, applicant attempted to refile in its rebuttal period evidence that it first attempted to file after the close of its case-in-chief. 77 U.S.P.Q.2d 1492, 1497-98 (T.T.A.B. 2005). In *Life Zone Inc. v. Middleman Group, Inc.*, the Board struck opposer's rebuttal evidence because it had not established a *prima facie* case and its rebuttal evidence went beyond applicant's evidence opposer sought to rebut. 87 U.S.P.Q.2d 1953, 1958 (T.T.A.B. 2008) (opposer claimed applicant 'opened the door' with its evidence; "[b]ut if this is true, that door opened onto a nearly empty room, because opposer had put little in it to begin with"; rebuttal evidence "went well beyond" the evidence it purported to correct). Similarly, in *The American Meat Institute et al. v. Horace W. Longacre, Inc.*, opposer failed to establish a *prima facie* case, only submitting during its case-in-chief "answers by applicant to specified interrogatories and requests for documents propounded by opposers." 211 U.S.P.Q. 712, 715-16, 720 (T.T.A.B. 1981). In *Capital City, LLC v. Select Brands LLC*, petitioner did not oppose the motion to strike with respect to the materials the Board found were cumulative, thus providing the Board with no explanation for how its rebuttal evidence was proper. 2013 WL 5402086, *4 (T.T.A.B. 2013).

prematurely consider whether Petitioner has made out a *prima facie* case, and then return to the issue again after submission of the trial briefs. (To avoid any doubt, Petitioner states it does not argue here whether it has made out a *prima facie* case, but, instead, only advances the above precedent as an additional reason why Respondent's objections to the rebuttal testimony of the three witnesses should not be considered now.)

II. Petitioner Is Entitled to Rebut Evidence Concerning the Impact of the U.S. Embargo On Likelihood of Confusion That *Respondent* Was Obligated to Come Forward With Under Board Precedent

During its trial period, Respondent introduced the testimony of its own employees and purported expert that U.S. consumers know that the U.S. trade embargo prohibits the sale of Cuban cigars in the United States and, for that reason, there is no likelihood of confusion despite the same name, COHIBA, being used for the same product, cigars. *See supra* PP.5-6; *see also, e.g.,* Deposition Eugene Paul Richter III, Respondent's Rule 30(b)(6) Witness, taken on Nov. 21, 2017, 259-262 REDACTED (a true and correct copy of which is attached hereto as Exhibit A); Deposition of Steven E. Abbot, taken on Dec. 16, 2020, 85-88 REDACTED (a true and correct copy of which is attached hereto as Exhibit B).

Under Board precedent, Respondent was obligated to come forward with evidence concerning knowledge of the embargo and its impact on likelihood of confusion, as it has attempted to do (whatever the admissibility, credibility or weight of that evidence). In primarily geographically deceptively misdescriptive cases, the Board has held that the U.S. party must come forward with evidence about U.S. consumers' knowledge about the embargo and that,

because of that knowledge, consumers will not make a goods/place association between cigars and Cuba.

In *In re Jonathan Drew, Inc.*, the Board rejected "applicant's argument that even if consumers view the term KUBA KUBA as related to Cuba, they would not likely believe that the goods [cigars] originate in Cuba because of the U.S. embargo on Cuban products" because "applicant ha[d] offered no evidence that the embargo on Cuban products would have any effect on the perception of KUBA KUBA as a geographically deceptive term." 97 U.S.P.Q.2d 1640, 1646-47 (T.T.A.B. 2011). When, a related applicant attempted to register the mark KUBA KUBA BY DREW ESTATE for cigars purportedly grown from "Cuban seed," the Board held that:

> applicant has offered no evidence or other reason to believe that the impression of KUBA KUBA on potential purchasers has in fact changed significantly in just three years
> …
> Cuba is well-known for the quality of its cigars and, despite the trade embargo, those cigars would be highly desirable to U.S. consumers, including those consumers who might incorrectly think that applicant's cigars are somehow eligible for an exception to the embargo, or even those who would believe – mistakenly – that applicant may be selling genuine Cuban cigars in violation of the law.

In re Drew Estate Holding Co., Serial No. 77840485, 2014 WL 1390500, at *5 (T.T.A.B. March 25, 2014) (Non-Precedential).

In *In re G & R Brands, LLC*, Serial No. 77417467 (T.T.A.B. 2010) (Non-Precedential), the Board rejected an argument, because made "without supporting evidence," that "U.S. consumers would understand that applicant's products [cigars and other tobacco products using the mark HAVANA TIME] do not come from Cuba, apparently because those consumers would be aware of the U.S.-Cuban embargo." *Id.* at 11. In *In re Boyd Gaming Corp.*, 57 U.S.P.Q.2d 1944, 1945, 47 (T.T.A.B. 2000), the

Board held that "applicant has presented no evidence to rebut [Examiner's] showing" of a goods/place association between Havana and clothes and cosmetics despite applicant's having argued that "no reasonable consumer will believe that applicant's goods come from Havana, Cuba … because … it is illegal under U.S. law to import and sell Cuban goods."[3]

This precedent is applicable here. In the geographically deceptively misdescriptive cases, the issue was whether consumers are not likely to mistakenly believe goods originate in Cuba because of their knowledge of the embargo; here, the issue is whether consumers are not likely to mistakenly make an association between Respondent's and Petitioner's COHIBA cigars ("likelihood of confusion") because they know there can be no such association because of the embargo. *See In re Save Venice New York, Inc.*, 259 F.3d 1346, 1355 (Fed. Cir. 2001) (primarily deceptively misdescriptve case citing to and applying the related goods test from likelihood of confusion cases).

Petitioner is clearly entitled to rebut evidence that *Respondent* was obligated to come forward with. It is "axiomatic" that Petitioner is entitled to present during its rebuttal testimony period "evidence or testimony that denies, explains, or discredits evidence adduced by" Respondent. 333 TTABVUE 12 (*Respondent's* motion citing cases). *See, e.g., Minnesota Mining and Manufacturing Co. v. Stryker Corp.*, 179 U.S.P.Q. 433, 434 (T.T.A.B. Aug. 23, 1973) (in opposition based on descriptiveness of a mark, "Opposer was under no obligation to refute a claim of secondary meaning [of the mark] until and when [this argument] was offered by

[3] The only point Petitioner's needs to make here, and the only point that it advances, is that Respondent has come forward with evidence on the embargo and its impact on likelihood of confusion, and it was obligated to do so under the Board's precedent. Petitioner need not, and does not, address the admissibility, effect or weight of Respondent's evidence.

applicant. Thus, it is our opinion that, in this case, this testimony constitutes proper rebuttal").

Here, in rebuttal to the evidence that Respondent came and was obligated to come forward with, Petitioner introduced:

- A page from Respondent's own website (published after Petitioner's case-in-chief) that one of only nine (9) "Frequently Asked Questions" on its cigar website is "Are Cuban cigars legal in the United States?" 308 TTABVUE 31 (Bailey Declaration) and exhibit cited therein;

- Evidence that there are frequent searches on the internet in the United States to try to find out whether it is legal or illegal to purchase Cuban cigars in the United States. 308 TTABVUE 29-31 (Bailey Declaration) and exhibits cited therein; and

- Numerous U.S. consumers on Reddit asking whether it is legal or illegal to purchase Cuban cigars in the United States. 308 TTABVUE 31-37 (Bailey Declaration) and exhibits cited therein.

- Leading search engines (Yahoo and Bing) direct U.S. consumers searching for the Cuban COHIBA cigar to General Cigar's COHIBA cigars, reflecting consumers belief that Cuban COHIBA cigars can be purchased in the United States, and also generating confusion as to whether it is legal or illegal to buy Cuban cigars in the U.S. or for a U.S. company to license or otherwise be associated with the company that produces Cuban COHIBA cigars. 308 TTABVUE 37-50 (Bailey Declaration) and exhibits cited therein.

- Instances of actual confusion between Respondent's and the Cuban COHIBA cigar. 308 TTABVUE 5-18 (Bailey Declaration) and exhibits cited therein (seven (7) instances of actual confusion from between 2016-2021).

- Instances of U.S. cigar retailers associating Respondent's COHIBA cigars with Cuba or the Cuban COHIBA cigar. 308 TTABVUE 19-20, 23-29 (Bailey Declaration) and exhibits cited therein.

- Even Respondent's premium COHIBA cigars are sold at low prices (as little as $2 to $3 per cigar) and in locations (gas stations and convenience stores) where consumer are not sophisticated or knowledgeable. 308 TTABVUE 50-59 (Gluth, Linehan and Bailey Declarations).

It is of no consequence that some (but not all) of this evidence was available to Petitioner prior to its rebuttal period. Petitioner was under no obligation to present evidence during its trial

period to rebut evidence that *Respondent* was under an obligation to come forward with.

Finally, some of the contested evidence post-dates Petitioner's trial period. 308 TTABVUE 11 (¶7), 18 (¶10), 19 (¶11), 22 (¶16), 24-25 (¶20), 25 (¶21), 26 (¶22), 31 (¶27), 34 (¶31), 35 (¶32), and 35 (¶33) and exhibits cited therein. Because Petitioner was under no obligation to present any evidence during its trial period to rebut evidence that *Respondent* was under an obligation to come forward with, there is no need for Petitioner to move to re-open its trial period to present evidence that post-dates its trial period, CITATION, contrary to Respondent's argument. 333 TTABVUE 15-18.

III. The Gluth and Linehan Testimony Is Not Barred Because of Improper Rebuttal Disclosures

The testimony of Gluth and Linehan should not be stricken for failure to disclose them as potential witnesses in Petitioner's initial disclosures, discovery responses or pretrial disclosures. As the Board has repeatedly held, "[i]n identifying individuals through initial disclosures, a party need not identify all those that may be called at trial as potential 'trial witnesses'…" *Spier Wines (Pty) Ltd. v. Ofer Z. Shepher*, 105 U.S.P.Q.2d 1239 (T.T.A.B. 2012). Rather, identification of witnesses for the first time in its rebuttal disclosures is permissible when either "substantially justified or harmless." Fed. R. Civ. P. 37(c)(1).

Respondent in its trial testimony provided evidence that its COHIBA cigars are not sold widely, or perhaps at all, at gas stations or at many convenience stores. This evidence was offered to support Respondent's position that the consumers of its COHIBA cigars are sophisticated and knowledgeable consumers of premium, high-priced cigars, and therefore would know the embargo prohibited the sale of Cuban cigars, and also that its COHIBA cigars are so expensive that consumers would make a careful investigation about the product before purchasing it. 287 TTABVUE 5 (Testimonial Deposition of Steven Abbot: "U.S. consumers do

not buy a COHIBA cigar on impulse or without considering the purchase and other cigar options before parting with their money. They are thus unlikely to be confused into thinking, before making a decision to buy a General Cigar COHIBA, that the cigar originates in Cuba or is sponsored or approved"); Deposition of Eugene Paul Richter III, taken on Nov. 24, 2020, at 48:22-49:10, 50:18-25 (Respondent's Vice-President of Sales: REDACTED (a true and correct copy of which is attached hereto as Exhibit C). Respondent should not have been surprised that Petitioner would submit evidence during its rebuttal period to explain or rebut its Vice-President of Sales' and Senior Brand Manager's testimony.

For rebuttal Petitioner, quite naturally, hired two investigators to go to gas stations and convenience stores to prove that Respondent's COHIBA cigars are sold there.

None of the cases cited by Respondent support its position that this investigator testimony should be barred because Petitioner did not make disclosures prior to Respondent's testimony which it rebuts. In fact, none of them concern the propriety of rebuttal disclosures at all. *See Jules Jurgensen/rhapsody, Inc. v. Peter Baumberger*, 91 U.S.P.Q.2d 1443, 1444-45 (T.T.A.B. 2009) (petitioner's sole trial witness's testimony was stricken because it failed to identify the witness in its pretrial disclosures and provided no explanation for this failure); *Spier Wines (Pty) Ltd. v. Ofer Z. Shepher*, 105 U.S.P.Q.2d 1239 (T.T.A.B. 2012) (opposer's trial witness, disclosed for first time in pretrial disclosures, was its employee); *Great Seats Inc. v Great Seats Ltd.*, 100 U.S.P.Q.2d 1323, 1327 (T.T.A.B. 2011) (Board allowed testimony of one trial witness identified for the first time in pretrial disclosures, but not those trial witnesses identified for the first time *after* pretrial disclosures were due); *Pepsico, Inc. v. Jay Pirincci*, 2013 WL 8456132, at *2 (Jan. 7, 2013) (applicant's pretrial disclosures indicated that it would

submit trial testimony of identified and unidentified expert witnesses, but applicant did not include the pretrial information required by 37 C.F.R. § 121(e) nor did it satisfy the expert disclosure requirements).

CONCLUSION

For the reasons stated above, Respondent's motion should be denied. In the alternative, the Board's consideration of Respondent's motion should be deferred (or denied without prejudice) until consideration of the Parties' trial briefs.

Dated: May 22, 2021

Respectfully submitted,

By: /Lindsey Frank /

MICHAEL KRINSKY
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212-254-1111
lfrank@rbskl.com
Attorneys for Empresa Cubana del Tabaco d.b.a. Cubatabaco

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing was served on Respondent by electronic mail on May 22, 2021 to:

/Lindsey Frank/
Lindsey Frank

Exhibit A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Registration No. 1147309

For the mark COHIBA

Date Registered: February 17, 1081 AND

In the matter of Trademark Registration No: 1898273

For the mark COHIBA

Date Registered: June 6, 1995

- - - - - - - - - - - - - - - - - x

EMPRESA CUBANA DEL TABACO, :

d.b.a. CUBATABACO, :

Petitioner, :

v. :

GENERAL CIGAR CO., INC. and :

CULBRO CORP., :

Respondents. :

- - - - - - - - - - - - - - - - - x

Deposition of GENERAL CIGAR CO., INC.

By and through its Designated Representative

EUGENE PAUL RICHTER, III

Richmond, Virginia

Tuesday, November 21, 2017 at 9:07 a.m.

Job No.: 164368
Pages: 1 - 381
Reported By: Leslie D. Etheredge, RMR, CCR

Deposition of EUGENE PAUL RICHTER, III, held at the offices of:

ECKERT SEAMANS CHERIN & MELLOTT
919 East Main Street, Suite 1300
Richmond, Virginia 23219
804.788.7740

Pursuant to Notice, before Leslie D. Etheredge, Registered Merit Reporter, Certified Court Reporter and Notary Public in and for the Commonwealth of Virginia.

A P P E A R A N C E S

ON BEHALF OF THE PETITIONER:

LINDSEY FRANK, ESQUIRE
RABINOWITZ, BOUDIN, STANDARD, KRINSKY
& LIEBERMAN
45 Broadway, Suite 1700
New York, New York 10006
212.254.1111

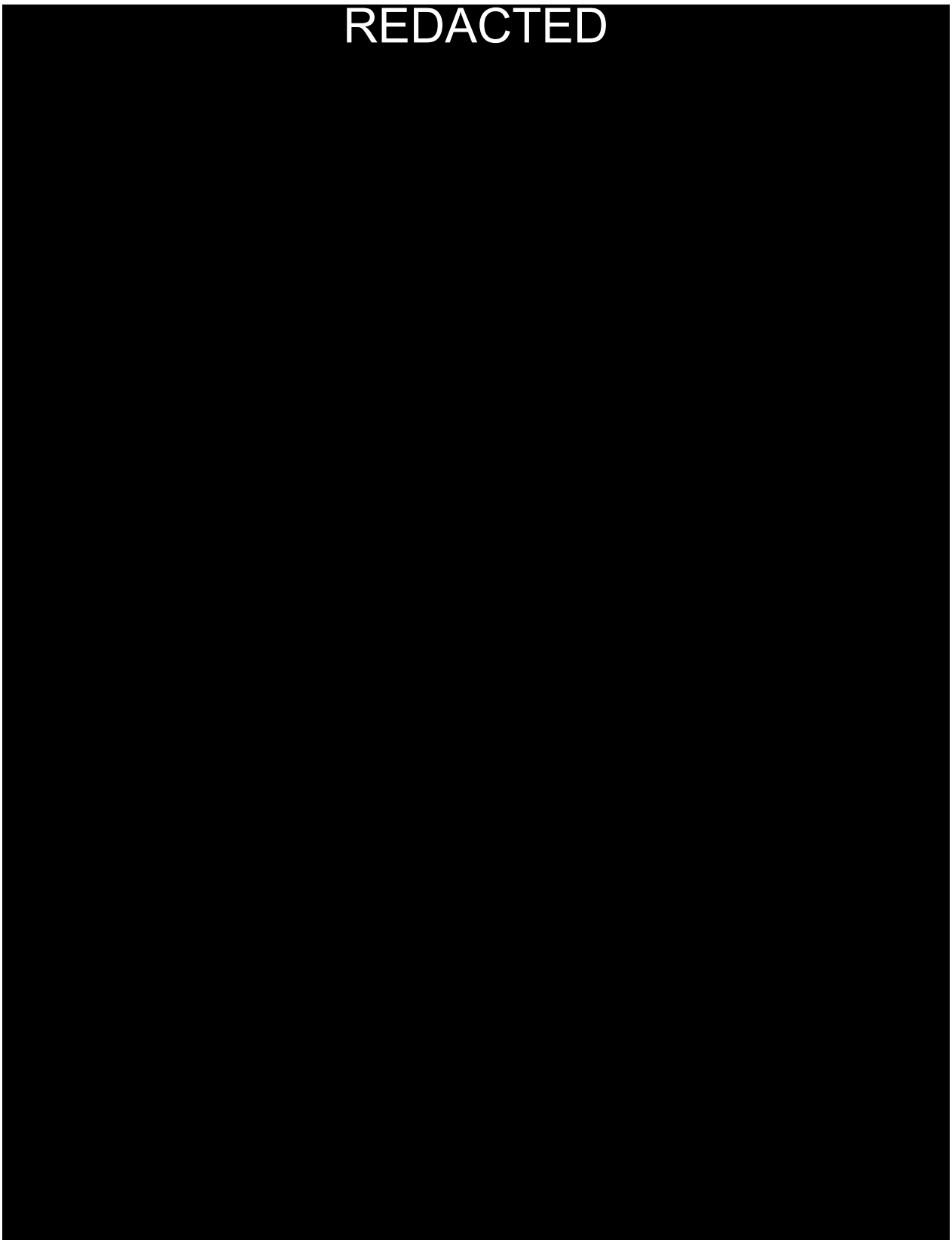
ON BEHALF OF THE RESPONDENTS:

AIRINA LYNN RODRIGUES, ESQUIRE
DLA PIPER LLP (US)
1251 Avenue of the Americas
New York, New York 10020
212.335.4673

REDACTED

REDACTED

REDACTED


REDACTED

No. 164368

Re: Deposition of **Eugene Paul Richter, III, Corporate Designee**
Date: 11/21/2017
Case: Empresa Cubana Del Tabaco -v- General Cigar Co., Inc. (TTAB)
Return to: transcripts@planetdepos.com

ACKNOWLEDGMENT OF DEPONENT

I, Eugene Paul Richter, III, Corporate Designee, do hereby acknowledge that I have read and examined the foregoing testimony, and the same is a true, correct and complete transcription of the testimony given by me and any corrections appear on the attached Errata sheet signed by me.

12/21/17 _____
(Date) (Signature)

CERTIFICATE OF SHORTHAND REPORTER - NOTARY PUBLIC

I, LESLIE D. ETHEREDGE, Registered Merit Reporter, Certified Court Reporter and Notary Public within and for the State of Virginia, do hereby certify:

That EUGENE PAUL RICHTER, III, the witness whose deposition is hereinbefore set forth, was duly sworn by me before the commencement of such deposition and that such deposition was taken before me and is a true record to the best of my ability of the testimony given by such witness.

I further certify that the adverse party, General Cigar Co., Inc., was represented by counsel at the deposition.

I further certify that the deposition of EUGENE PAUL RICHTER, III occurred at the offices of ECKERT SEAMANS CHERIN & MELLOTT, 919 East Main Street, Suite 1300, Richmond, Virginia on Tuesday, November 21, 2017, commencing at 9:07 a.m. to 8:36 p.m.

I further certify that I am not related to any of the parties to this action by blood or

marriage, I am not employed by or an attorney to any of the parties to this action, and that I am in no way interested, financially or otherwise, in the outcome of this matter.

IN WITNESS WHEREOF, I have hereunto set my hand this 29th day of November, 2017.

LESLIE D. ETHEREDGE, Notary Public in and for the Commonwealth of Virginia
Registration No: 116406
My commission expires February 28, 2019

Exhibit B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CANCELLATION NO. 92025859

In the matter of Trademark Registration No. 1147309
For the mark COHIBA
Date registered: February 17, 1981
-and-
In the matter of Trademark Registration No. 1898273
For the mark COHIBA
Date Registered: June 6, 1995

EMPRESA CUBANA DEL TABACO, d.b.a CUBATABACO,

Petitioner,

v.

GENERAL CIGAR CO., INC., and CULBRO CORP.,

Respondents.

CONFIDENTIAL - ATTORNEYS' EYES ONLY

AUDIO-VISUAL DEPOSITION OF

STEVEN ABBOT

December 16, 2020

11:17 a.m. - 3:49 p.m.

Audio-Visual Deposition of STEVEN ABBOT, taken and transcribed on behalf of the Petitioner, stenographically reported by Kimberly L. Ribaric, Registered Professional Reporter, Certified Court Reporter and e-Notary Public in and for the Commonwealth of Virginia at large, pursuant to TBMP 703.01(e) and 37 C.F.R. Section 2.123(a)(1), and by Notice to Take Depositions; commencing at 11:17 a.m., December 16, 2020.

APPEARANCES OF COUNSEL:

RABINOWITZ, BOUDIN, STANDARD, KRINSKY & LIEBERMAN, P.C.
14 Wall Street, 30th Floor
New York, NY 10005
lfrank@rbskl.com
BY: LINDSEY FRANK, ESQUIRE
Counsel for Petitioner

DLA PIPER, LLP (US)
2000 Avenue of the Stars
Suite 400 North Tower
Los Angeles, California 90067-4704
andrew.deutsch@dlapiper.com
BY: ANDREW L. DEUTSCH, ESQUIRE
Counsel for Respondent

ALSO PRESENT:

OWEN MCKEON, General Counsel for Scandinavian Tobacco

REDACTED

REDACTED

REDACTED

REDACTED

CHANGES REQUESTED TO THE DEPOSITION OF:

STEVEN ABBOT

TAKEN: December 16, 2020

PAGE/LINE:	DESCRIPTION
Corrections made on transcript pages (p.5)	

DATE: 2/2/2021

SIGNATURE: [signature]

NOTARY PUBLIC: [signature]

MY COMMISSION EXPIRES: 02-29-2024

TYEE ALLEN
NOTARY PUBLIC
REGISTRATION # 7886449
COMMONWEALTH OF VIRGINIA
MY COMMISSION EXPIRES
FEBRUARY 29, 2024

REPORTED BY: Kimberly L. Ribaric, RPR, CCR

COMMONWEALTH OF VIRGINIA AT LARGE, to wit:

I, Kimberly L. Ribaric, Registered Professional Reporter, Certified Court Reporter and Electronic Notary Public in and for the Commonwealth of Virginia at Large, and whose commission expires August 31, 2024, do certify that the aforementioned appeared audio-visually before me, was sworn by me, was thereupon examined by counsel, that review was requested; and that the foregoing is a true, correct, and full transcript of the testimony adduced.

I further certify that I am neither related to nor associated with any counsel or party to this proceeding, nor otherwise interested in the event thereof.

Given under my hand and notarial seal at Fluvanna County, Virginia, this 4th day of January 2021.

Kimberly L. Ribaric

Kimberly L. Ribaric, RPR, CCR
Electronic Notary Public Registration No. 348266
My commission expires: 8/31/2024
Commonwealth of Virginia at Large

Exhibit C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
CANCELLATION NO. 92025859

In the matter of Trademark Registration
No. 1147309 for the mark COHIBA
Date registered: February 17, 1981

-and-

In the matter of Trademark Registration
No. 1898273 for the mark COHIBA
Date registered: June 6, 1995

EMPRESA CUBANA DEL TABACO, d/b/a
CUBATABACO,

Petitioner(s),

vs.

GENERAL CIGAR CO., INC., and
CULBRO CORP.,

Respondent(s).

CONFIDENTIAL - ATTORNEYS' EYES ONLY

VIDEOCONFERENCE DEPOSITION OF

EUGENE PAUL RICHTER, III

NOVEMBER 24, 2020

REPORTED BY: Susan Ashe, CSR, RMR, CRR

ESQUIRE DEPOSITION SOLUTIONS, LLC

1384 Broadway - 22nd Floor

New York, New York 10018

(212) 687-2010

Job No. J6151445

Videoconference Deposition of:

EUGENE PAUL RICHTER, III

called for oral examination by counsel for Petitioner, pursuant to notice, via Zoom, all parties remote, before Susan Ashe, CSR, RMR, CRR, of Esquire Solutions, a Notary Public in and for the Commonwealth of Virginia; taken on Tuesday, November 24, 2020, beginning at 9:35 a.m., when were present on behalf of the respective parties:

On behalf of Petitioner:

LINDSEY FRANK, ESQUIRE
Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C.
14 Wall Street, 30th Floor
New York, New York 10005
(212) 254-1111
lfrank@rbskl.com
(Via Videoconference)

On behalf of Respondent and the Witness:

JOHN NADING, ESQUIRE
JOSHUA SCHWARTZMAN, ESQUIRE
DLA Piper
500 8th Street, Northwest
Washington, D.C. 20004
(202) 799-4000
john.nading@dlapiper.com
joshua.schwartzman@dlapiper.com
(Via Videoconference)

ALSO PRESENT:
Eden Marley, DLA Piper

REDACTED

REDACTED

REDACTED

CERTIFICATE

I, SUSAN ASHE, a Registered Merit Reporter and Notary Public, hereby certify that the foregoing is a true and accurate transcript of the deposition of said witness, who was first duly sworn by me on the date and place hereinbefore set forth.

I FURTHER CERTIFY that I am neither attorney nor counsel, nor related to or employed by any of the parties to the action in which this deposition was taken, and further that I am not a relative or employee of any attorney or counsel employed in this action, nor am I financially interested in this case.

Dated this 25th day of November 2020.

_____

Susan Ashe, Notary Public
for the Commonwealth of Virginia
My commission expires: January 31, 2024.
Registration Number: 100809.

ERRATA SHEET FOR THE TRANSCRIPT OF:

Case Name: Empresa Cubana Del Tabaco d/b/a Cubatabaco

Dep. Date: November 24, 2020

Deponent: Eugene Paul Richter, III

Pg.	Ln.	Now Reads	Should Read	Reason
		" NO CHANGES"		

Signature of Deponent

SUBSCRIBED AND SWORN BEFORE ME

THIS 23 DAY OF December, 2020.

(Notary Public) MY COMMISSION EXPIRES: 10/31/24

AMBER L BYRD NOTARY PUBLIC REG # 7894469 MY COMMISSION EXPIRES 10/31/2024 COMMONWEALTH OF VIRGINIA